



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/044,086	04/29/87	CROSS	F. C. (IN-PH)

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EXAMINER	
COVINGTON, R	
ART UNIT	PAPER NUMBER
129	4

DATE MAILED:

10/25/88

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 4/29/87 8/1/88 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449 | 4. <input type="checkbox"/> Notice of informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474 | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-59 are pending in the application.
Of the above, claims 55, 57 & 59 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-54, 56 & 58 are rejected.
5. ☐ Claims _____ are objected to.
6. ☒ Claims 1-59 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☒ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☒ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-57, drawn to amine derivative compounds, classified in Class 544, subclass 174, for example.

II. Claim 58, drawn to sulfonamide compositions, classified in Class 564, subclass 84, for example.

III. Claim 59, drawn to a method for treating anhythmia, classified in Class 514, subclass 821, for example.

The inventions are distinct, each from the other, because of the following reasons:

Inventions I and II are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in a materially different combination. MPEP 806.05(c).

In this case, the combination as claimed does not require the particulars of the subcombination for patentability because Group I does not require a sulfonamide substituent. Additionally, the subcombination has separate utility such as a herbicide.

Inventions I and III are related as product and process of use.

The inventions are distinct if either (1) the process for using the product as claimed can be practiced with another and materially different product, or (2) the product as claimed can be used in a materially different process of using the product. MPEP 806.05(h).

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In this case, the product as claimed can be used in a materially different process such as a lubricating agent.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Robert Sheyka on September 16, 1988 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-57. Affirmation of this election must be made by applicant in responding to this Office action. Claims 58 and 59 have been withdrawn from further consideration by the examiner as being drawn to a nonelected invention. See 37 CFR 1.142(b).

Applicants were also required under 35 USC 121 to elect a single disclosed species. Applicants elected the species of claim 54. Accordingly, claims 55 and 57 have been withdrawn from consideration as not being directed to the elected subject matter. Claim 58, previously withdrawn will, in light of the elected species, be considered to the extent it reads ~~on~~ on the subject matter therein.

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Claims 4, 6, 11, 12, 16, 18, 23, 24, 28, 30, 35, 36, 40, 42, 43, 48 and 49 are rejected under 35 USC 112 fourth paragraph as they are substantial duplicates and/do not further limit the claim from which they depend. The relationships are:

Claims 4 \approx 6	Claims 11 \approx 12
16 \approx 18	23 \approx 24
30 \approx 28	35 \approx 36
40 \approx 42 \approx 43	48 \approx 49

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103.

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Claims 1-54, 56 and 58 rejected under 35 U.S.C. 103 as being unpatentable over Ainsworth et al I or Ainsworth et al II taken with Howe et al, Larsen et al I and Larsen et al II in view of Hester.


Ainsworth et al I and II teach compounds of the same type recited. See column 1 lines 17-28 where R₁ is methylsulphonylamide and column 2 lines 7-26 where R₆R₇=hydrogen Y is alkylene. X is oxygen and R₄ is amide, both references and column 3 lines 8-18 Ainsworth et al I lines 15-38 Ainsworth et al II. Patentee does not specifically teach the presence of a sulfonamide substituent on the phenoxy. Howe et al, however, teaches analogous compounds employing amides per se or sulfonamides. See claim 3 lines 39 and 44. To modify Ainsworth et al I and II to make a beta blocking agent would be obvious particularly in view of Larsen et al I and II which teach, generically, compounds of the type claimed. See Larsen et al I column 1 lines 32+ and column 2 lines 1-4, and Larsen et al II column 1 lines 20-64. As to the presence of hydroxy substituents on the rings or alkyl chain; Hester shows hydrogen and hydroxy to be readily interchangeable in analogous compounds. Thus in light of the foregoing the claimed invention would have been prima facie obvious to one of ordinary skill and therefore unpatentable.

No claim has been allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner R. Covington whose telephone number is (703) 557-1205.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 557-3920.

COVINGTON:cij
09/29/88
10/12/88


GLENNON H. HOIDAL
SUPERVISORY PATENT EXAMINER
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